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PATENT APPLICATION

ATTORNEY DOCKET NO. __10005030-1____

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):   Darrel D. Cherry

Application No.:09/814,302

Filing Date: Mar. 21, 2001

Title: System And Method For Providing A History List Of Existing Imaging Compositions

Confirmation No.: 4822

Examiner: Asghar Bilgrami

Group Art Unit: 2143

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

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TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on __Mar. 16, 2005____.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)
     for the total number of months checked below:

        ( ) one month $120.00
        ( ) two months $450.00
        ( ) three months $1020.00
        ( ) four months $1590.00

    ( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is
     being made to provide for the possibility that applicant has inadvertently overlooked the need
     for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of ____$500.00____. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Number of pages 12

Respectfully submitted,

Darrel D. Cherry

By_____

Jack H. McKinney
Attorney/Agent for Applicant(s)

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PATENT APPLICATION
DOCKET NO. 10005030-1

IN THE
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INVENTOR(S) : Darrel D. Cherry   **GROUP ART UNIT: 2143**

SERIAL NO.:   09/814,302   **EXAMINER:** Asghar H. Bilgrami

FILED: 03/21/2001

SUBJECT: **SYSTEM AND METHOD FOR PROVIDING A HISTORY LIST OF**
                  EXISTING IMAGING COMPOSITIONS

APPELLANTS'/APPLICANTS' OPENING BRIEF ON APPEAL

1. REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a
limited partnership established under the laws of the State of Texas and having a
principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter
"HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of
Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA.
The general or managing partner of HPDC is HPQ Holding, LLC.

2. RELATED APPEALS AND INTERFERENCES.

There are no other appeals or interferences known to Appellants, Appellants'
legal representative or the Assignee which will affect or be directly affected by or have
a bearing on the Board's decision in the pending appeal.

3.   **STATUS OF CLAIMS.**

Claims 1-12 are pending and stand rejected. All pending claims are appealed.

4.   **STATUS OF AMENDMENTS.**

No amendments have been filed after the final action was entered. All previous amendments, if any, have been entered.

5.   **SUMMARY OF CLAIMED SUBJECT MATTER.**

Claim 1 recites a system a system for distributing information. The system includes a first client computer having first software with a print functionality. *See, e.g.,* Specification, page 5, lines 3-10. The system includes a second client computer and a network connecting said first and second client computers. *See, e.g.,* Specification, page 4, lines 18-25. The system also includes means for effecting communication of a document from the first client to the second client as email via the print functionality thereof. *See, e.g.,* Specification, page 5, lines 3-23. Claims 2-8 each ultimately depend from Claim 1.

Claim 9 recites a system for distributing information. The system includes a plurality of client computers. *See, e.g.,* Specification, Page 4, lines 18-25. At least one client computer includes application software with a print functionality. *See, e.g.,* Specification, page 5, lines 3-10. The system includes a server and a network connecting the client computers and the server. *See, e.g.,* Specification, page 4, lines 18-25. Also included is a means for effecting communication of a document from the first client to the second client through the server as email via the print functionality of the application software. *See, e.g.,* Specification, page 5, lines 3-23. The means for effecting communication includes a first agent running on the client and a second agent running on the server. *See, e.g.,* Specification, page 5, lines 3-23.

Claim 12 recites a method for distributing information. The method includes providing a first client computer with first software with a print functionality. *See, e.g.,* Specification, page 5, lines 3-10. A second client computer is provided. *See, e.g.,* Specification, Page 4, lines 18-25. The first and second client computers are connected with a network. *See, e.g.,* Specification, Page 4, lines 18-25. Communication of a document from said first client to said second client as email via

said print functionality of said first client is effected. *See, e.g.,* Specification, page 5, lines 3-23.

6.   **GROUNDS FOR REJECTION TO BE REVIEWED.**

   A.   Weiser (USPN 5,982,507) does not teach or suggest means for effecting communication of a document from the first client to the second client as email via the print functionality of the first client.

   B.   Weiser (USPN 5,982,507) does not teach or suggest effecting communication of a document from the first client to the second client as email via the print functionality of the first client.

7.   **ARGUMENT.**

   A.   **Ground for Rejection A (Claims 1-11) – Weiser (USPN 5,982,507) does not teach or suggest means for effecting communication of a document from the first client to the second client as email via the print functionality of the first client.**

Claims 1-11 were rejected under 35 U.S.C. §102(b) as being anticipated by USPN 5,982,507 issued to Weiser. Claim 1 recites a system for distributing information that includes the following combination of elements.

   1. a first client computer having first software with a print functionality;
   2. a second client computer;
   3. a network connecting said first and second client computers; and
   4. means for effecting communication of a document from said first client to said second client as email via said print functionality thereof.

With respect to each element listed above, the Examiner asserts that Weiser, col. 4, lines 26-44 and col. 5, lines 1-6 disclose the claimed invention. According to its abstract, Weiser is directed to enabling:

> message routing capabilities to and from conventionally headerless apparatus, such as scanners and digital copiers. The apparatus work in conjunction with a document router to provide full-featured and secure message routing capabilities, including scanning images directly to an

electronic mailbox, and retrieving messages from within the messaging environment for output at the apparatus.

Weiser, Abstract. In short, Weiser discloses the use of a scanner/copier to send and receive messages within a network. The sent messages include scanned or digitized data sent to an electronic mailbox. Weiser, col. 14, line 50 through col. 15, line 34. The received messages include data such as electronic mail messages to be printed. Weiser, col. 15, lines 35-65. Weiser mentions nothing of sending or receiving these messages using software print functionality.

As for the passages of Weiser cited by the Examiner, col. 4, lines 26-44 read as follows:

> FIG. 1 shows a messaging environment 20 according to one embodiment of this invention. The phrase `messaging environment` refers to a network in which a message, such as a file, a document or the like can be transmitted over the network. As used herein, the word message is used to refer to a unit of data which can be transferred within a networking environment, such as an e-mail message, an image, a file, a document, a record, and the like. Local area networks (LAN) 23, 35 contain various conventional network-attached apparatus such as network servers 32, 33 client computers 24, 25 and printers 26, 27, as well as apparatus which are not conventionally network-attached, such as digital copiers 28, 29 and scanners 30, 31. Networks 23, 35 can comprise any suitable communications technology such as Ethernet, Token-Ring, FDDI and the like, and any suitable networking topology such as IPX/SPX, TCP/IP and the like. Networks 23 can communicate with one another over a conventional wide area network 22.

and col. 5, lines 1-6 read:

> As another example, a user could enter transmission data at digital copier 28 to request that all unopened e-mail messages of the user be transferred from within messaging environment 20 to digital copier 28. According to this invention, message transmission can include directing messages to and from a remote local area network, such as network 35 via WAN 22.

Nothing in these passages (or elsewhere) teaches means for effecting communication of a document from the first client to the second client as email via software print functionality. As clarified above, Weiser simply discusses using a device such as a scanner to send scanned images to an electronic mailbox and using a device such as a digital copier to retrieve and print electronic mail messages. While Weiser

mentions the communication of data between devices, it does not teach communicating the data via software print functionality. Simply stated, Weiser neither mentions nor suggests effecting communication of a document via email by utilizing the print functionality of software operating on a client.

For at least this reason, Claim 1 is felt to distinguish over Weiser. Claims 2-8 are also felt to distinguish patentably based at least on their dependency from Claim 1.

Claim 9 recites a system for distributing information that includes the following combination of elements:

1. a plurality of client computers, at least one client computer having application software with a print functionality;
2. a server;
3. a network connecting said client computers and said server; and
4. means for effecting communication of a document from said first client to said second client through said server as email via said print functionality of said application software, said means effecting communication including a first agent running on said client and a second agent running on said server.

With respect to each element listed above, the Examiner asserts that Weiser, col. 4, lines 26-44 and col. 5, lines 1-6 disclose the claimed invention. As discussed above with reference to Claim 1, nothing in these passages (or elsewhere) teaches means for effecting communication of a document from the first client to the second client as email via the software print functionality of the first client. Moreover, when rejecting Claim 9, the Examiner failed to even address the additional requirement that the means for effecting communication include first and second agents.

For at least these reasons, Claim 9 is felt to distinguish over Weiser. Claims 10 and 11 are also felt to distinguish patentably based at least on their dependency from Claim 9.

B.   Ground for Rejection B (Claim 12) – Weiser (USPN 5,982,507) does not teach or suggest effecting communication of a document from the first client to the second client as email via the print functionality of the first client.

Claim 12 was rejected under 35 U.S.C. §102(b) as being anticipated by USPN 5,982,507 issued to Weiser. Claim 12 recites a method for distributing information that includes the following combination of elements:
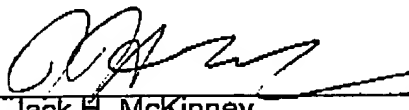
1. providing a first client computer with first software with a print functionality;
2. providing a second client computer;
3. connecting said first and second client computers with a network; and
4. effecting communication of a document from said first client to said second client as email via said print functionality of said first client.

With respect to each element listed above, the Examiner asserts that Weiser, col. 4, lines 26-44 and col. 5, lines 1-6 disclose the claimed invention. As discussed above with reference to Claims 1 and 9, nothing in these passages (or elsewhere) teaches means for effecting communication of a document from the first client to the second client as email via the software print functionality of the first client. Consequently, nothing in these passages teaches the act of effecting communication of a document from said first client to said second client as email via said print functionality of said first client.

For at least these reasons, Claim 12 is felt to distinguish over Weiser.

Respectfully submitted,
Darrel D. Cherry, *et al.*

By _____

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APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

1. A system for distributing information comprising:

a first client computer having first software with a print functionality;

a second client computer;

a network connecting said first and second client computers; and

means for effecting communication of a document from said first client to said second client as email via said print functionality thereof.

2. The invention of Claim 1 wherein said first software is application software.

3. The invention of Claim 1 further including a server connected to said network.

4. The invention of Claim 3 wherein said means for effecting communication includes means for communicating said document through said server.

5. The invention of Claim 4 wherein said means effecting communication includes a first agent running on said client.

6. The invention of Claim 5 wherein means for communicating includes a second agent running on said server.

7. The invention of Claim 1 further including email software running on said second client for receiving said document.

8. The invention of Claim 7 wherein said email software includes means for receiving a message associated with said document from said first client.

9. A system for distributing information comprising:

a plurality of client computers, at least one client computer having application software with a print functionality;

a server;

a network connecting said client computers and said server; and

means for effecting communication of a document from said first client to said second client through said server as email via said print functionality of said application software, said means effecting communication including a first agent running on said client and a second agent running on said server.

10. The invention of Claim 9 further including email software running on said second client for receiving said document.

11. The invention of Claim 10 wherein said email software includes means for receiving a message associated with said document from said first client.

12. A method for distributing information including the steps of:
providing a first client computer with first software with a print functionality;
providing a second client computer;
connecting said first and second client computers with a network; and
effecting communication of a document from said first client to said second client as email via said print functionality of said first client.

Evidence Appendix

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

Related Proceedings Appendix

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.